

Atty Docket No. 18668-US1  
Serial No. 10/087,082  
Amendment under 37 CFR 1.116 Expedited Procedure  
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## REMARKS

### Status of the claims

Claims 1, 3-17 are pending and under consideration. Claims 1 and 9 are currently amended. Support for the claim amendments, limiting the methods to the amplification of DNA, is found throughout the specification; for example on page 1 lines 8-9 of the specification as filed: "The invention provides an improved method of 'whole genome amplification' (WGA) that is suitable for performing DNA analysis...". Accordingly, no new matter is added, and Applicants respectfully request entry of the amendments.

### Claim Rejection – 35 USC § 103

The Office has maintained the rejection of claims 1 and 3-17 under 35 U.S.C 103(a) as being unpatentable over Eggeling et al. in view of Biochemicals Catalog (Action page 3). The Office asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to amplify nucleic acid fragments of Eggeling in a manner taught by the Biochemicals Catalog. (Action pages 4-5.)

While not acquiescing to the Office's arguments, Applicants have amended Claims 1 and 9 to limit the methods to the amplification of DNA. The Biochemicals Catalog publication discloses a Titan One Tube RT-PCR system which is used for analyzing RNA from a sample with high fidelity, but the publication does not disclose a system for DNA. Additionally, the figures presented in the Biochemicals Catalog publication disclose the amplification of various RNA samples, but not DNA samples. The methods claimed in the instant application as amended only apply in the context of analysis of genomic DNA.

Applicants assert that a person of ordinary skill in the art would not have been motivated to use the enzyme blend as described by the Biochemicals Catalog for use in RNA amplification, in the DNA amplification method of Eggeling. The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. See *In re Mills*, 916 F.2d 680, 15 USPQ2d 1430 (Fed. Cir. 1990): although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so". MPEP 2143.01 (III). Furthermore, '[t]he statement that

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modifications of the prior art to meet the claimed invention would have been 'well within the ordinary skill of the art at the time the claimed invention was made' because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references." MPEP 2143.01 (IV) (emphasis added). The Office has not demonstrated that a person of ordinary skill in the art would have been motivated to use an enzyme blend taught by the prior art to be useful in an RNA PCR for a DNA analysis method. The Office has not provided an objective reason to combine the teachings of Eggeling with the enzyme blend in the Biochemicals Catalog, and thus has failed to establish a *prima facie* case of obviousness.

Applicants further assert that an ordinary artisan would not have a reasonable expectation of success that the use of the Biochemicals Catalog enzyme blend described for RNA PCR would result in any benefit to DNA PCR methods as per Eggeling, as compared to the use of a single polymerase. The Office has not demonstrated that, in the absence of secondary considerations, the use of the Biochemicals enzyme blend in DNA amplification would have resulted in the same benefits of increased fidelity as demonstrated for RNA PCR in the Biochemicals Catalog publication.

Because the Office has not established a *prima facie* case of obviousness for the reasons set forth above, Applicants respectfully request reconsideration and withdrawal of the §103 rejections.

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### CONCLUSION

Applicants respectfully assert that the present application is in condition for allowance and request that the Office issue a timely Notice of Allowance.

Please grant any extensions of time required to enter this Response under 37 CFR §1.116, and charge any additional fees or credit any overpayments to Deposit Account No. 50-0812.

Please direct all future correspondence to: Customer No. 22829.

Respectfully submitted,

Date: 5/9/06

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